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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,597	03/13/2001	Carolyn W. Hall	HALL-101	4573

7590
Robert K. Tendler
65 Atlantic Avenue
Boston, MA 02110

08/12/2003

EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 08/12/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,597

Applicant(s)

HALL ET AL.

Examiner

Kathleen M Christman

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3713

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/18/2003 has been entered, claims 1-24 have been cancelled; claims 25-44 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 25-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "at a pre-selected times" in claim 25, should be recited as "at a pre-selected time" so as to clarify that the guided practice activities to are sent at one pre-selected time during the day. Further regarding claim 38, the claim is unclear and indefinite. Applicant has provided no method step to show how the guided practice of capable of empowering women to react to specific workplace encounters with positive results. Claims 26-37 and 39-42 are rejected for their incorporation of one or more of the above defects through their dependencies.

Claim Rejections - 35 USC § 102

Art Unit: 3713

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 25, 28, 30-32, 35, 43, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith (US 6338628 B1). The broadly claimed method for behavioral modification in the learning process may be interpreted as the personal training and development delivery method of Smith. Smith teaches a method including the steps of: providing at an Internet Site a course of instruction having a number of guided practice activities to be performed by an individual, each guided practice including information on how to modify behavior (see col. 14: 60 - col. 15: 6); and automatically transmitting the guided practice activity to the individual at a pre-selected times, thus to provide the individual with an active learning experience through the guided practice activity pushed from the Internet site at pre-selected times during the day (see col. 13: 54-55 and col. 14: 43-44), as in claim 25. Providing the individual with additional guided practices from the Internet site (claim 28) is taught at col. 14: 50-54. Preceding a guided practice activity with a mini-lesson (claims 30 and 44) is taught by the "training" materials of Smith, as shown in col. 13: 19-23. Providing a device to which the guided practice activity is transmitted (claim 31) where the device is a computer (claim 32) is shown in col. 14: 61-62. The guided practice activity being designed to improve competency in the workplace (claim 35) is taught at col. 11: 58. Regarding the system of claim 43, Smith teaches a website coupled to the internet (see Figure 6); a course of study available at said website including guided practice activities, each guided practice activity including information on how to modify behavior (see col. 14: 60 - col. 15: 6); means for automatically transmitting to the individual said guided practice activities at predetermined times during the day (see col. 13: 54-55 and col. 14: 43-44);

Art Unit: 3713

and a device available to the individual and coupled to the Internet for receiving the automatically transmitted guided practice activities and prompting the individual to take action in the form of practice (col. 14: 61-62).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 6338628 B1) in view of Brown et al (US 5879163) or Casey-Cholakis et al (US 6438353 B1) or Tsumori et al (US 6435880 B1). Smith fails to particularly teach that the guided practice activity is an athletic activity (claim 36), where the athletic activity is golf (claim 37), designed to empower women to react to specific workplace encounters with positive results (claim 38), designed to improve the response of the individual to health related issues (claim 39) wherein the health related issues in controlling the weight of the individual (claim 40), addiction (claim 41) or the taking of medication (claim 42). Each of the limitations is a variation of the subject matter presented to the user upon receipt of the guided practice. Brown et al teaches using an education system to modify behavior for various medical conditions. Tsumori et al teaches using an educational system for modifying behavior and teaching a user various athletic activities, including golf. Casey-Cholakis et al teaches using an educational system to educate a student on office policies, such as sexual harassment and proper responses to such. Each of these systems show that educational content may be created to teach a plurality of topics. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the educational content of any of the references within the Smith system so as to provide a plurality of topics for education.

Art Unit: 3713

5. Claims 26, 27, 29, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 6338628 B1) in view of Fargano (US 6257896 B1). Smith teaches all limitations of the claimed invention as shown above, except the guided practice activities are transmitted to the individual at times preselected by the individual such that the guided practice activities are not disruptive (claim 26); providing acknowledgement of receipt of a guided practice activity and transmitting the acknowledgement back over the Internet to the Internet Site (claim 27); the guided practice activities from the Internet site are time limited so as not to interfere with the normal tasks of the individual (claim 29); the automatic transmission is at a pace so as not to disrupt the individual during his workday (claim 33); and the guided practice includes experiential learning in which the individual is prompted to respond with some action (claim 34). Fargano teaches these limitations at col. 1: 36-40 and col. 5: 9-10; col. 3: 10; col. 4: 59-61; col.3: 35; and col. 7: 15-22, respectively. As Smith does not specifically teach the scheduling of the delivering of information in method/system one of ordinary skill in the art would be forced to seek other systems. As such it would be obvious to one of ordinary skill in the art to use a delivery system such as that taught by Fargano to deliver the educational materials of Smith so as to provide an "ongoing skill building method and system implemented in such a way that the training subject is not overburdened by the ongoing training process". (Fargano Background)

Response to Arguments

6. Applicant's arguments with respect to claims 25-44 have been considered but are generally moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Hitchcock et al (US 5823781) teaches a system where training is scheduled based on a user's regular schedule

Art Unit: 3713

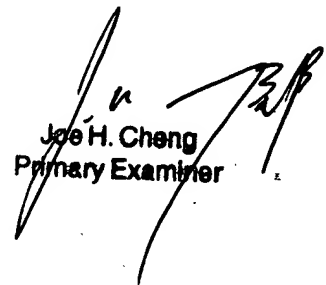
- b. Douglas et al (US 6039688) teaches a system and method for behavioral modification, directed primarily towards the medical area

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Theresa Walhberg can be reached on (703) 308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Kathleen Christman
August 7, 2003


Joe H. Cheng
Primary Examiner